

### **REMARKS**

In view of the following remarks, the Examiner is respectfully requested to withdraw the rejections and allow Claims 48-50, 52 and 58-68, as well as new Claims 96-113, the only claims pending and currently under Examination in this application.

Claims 48, 66, and 67 have been amended for clarification. Support for these amendments can be found in the specification, for example on pg. 11, lines 8-16; pg. 13, lines 5-13; and pg. 14, lines 4-7. New Claims 96 to 113 find support in the claims as originally filed, as well as in the specification, e.g., a paragraphs 0013, 0015, 0017, 0043, 0048, 0049 and 0054, as well as original Claims 38 and 39. Accordingly, no new matter has been added. As no new matter has been added by way of these amendments, entry thereof by the Examiner is respectfully requested.

### ***Claim Objections***

Claims 48-52 and 57-65 have again been objected to in that the Office alleges that there is no antecedent basis for the one common electrical conductor in line 7. The Applicants believe that this objection may have been inadvertently included in the current Office Action, as independent Claim 48 was previously amended in line 3 to recite "one common electrical conductor". In view of this amendment, this objection may be withdrawn.

### ***Claim Rejections - 35 U.S.C. § 102***

Claims 48-52, and 57-68 have been rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by Edwards et al. (U.S. 6,163,716).

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Bros. v. Union Oil of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

An element of the rejected claims is the presence of at least two separately identifiable effectors or actuators on an elongate body, wherein the effectors or actuators (Claim 66) are axially spaced apart along the length of the body, and wherein each of the at least two effectors or actuators comprises a separately identifiable processor. The effectors or actuators are electrically coupled to the at least one common conductor.

In maintaining the rejection, the Office alleges that Edwards teaches "a device including a body including catheter 118 and ferrule 132, a plurality of effectors mounted on the attached to the body, where each effector is composed of chip 106 with an identifiable microprocessor 92, and spline 76" (Office Action, p. 3)

However, the Applicants maintain that Edwards does not contain the element of at least two separately identifiable effectors or actuators on an elongate body, wherein the effectors or actuators are axially spaced apart along the length of the body. Edwards does not contain this element, because the effectors in Edwards, which the Office considers to be composed of "chip 106 with an identifiable microprocessor 92, and spline 76", are arranged in a circle perpendicular to the long axis, or length of the body, as shown in FIG. 21 reproduced below:

**FIG. 21**

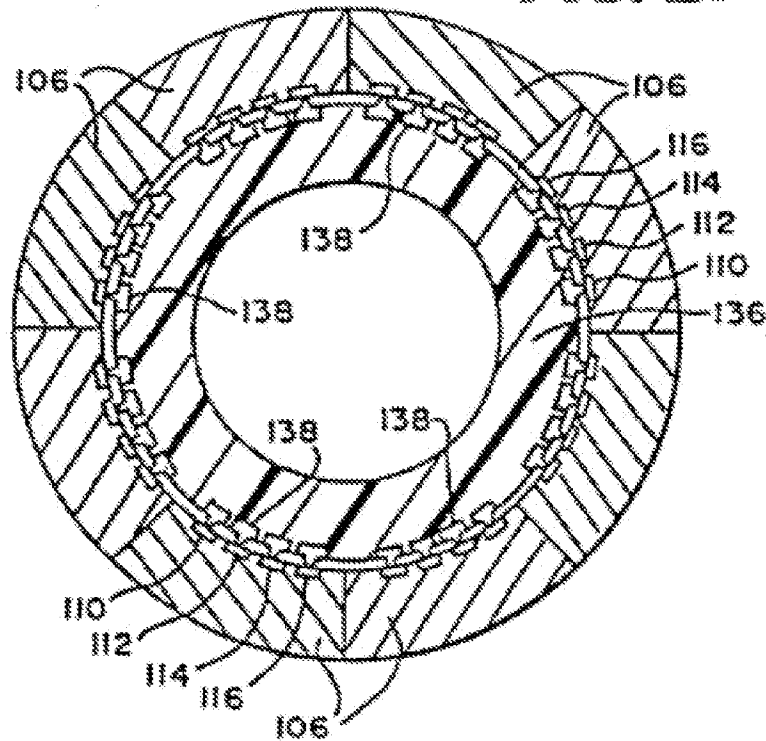


FIG. 21 shows chips 106 arranged in a circle around stainless steel ferrule 136, in an orientation which is perpendicular to the length of the body comprised of "catheter 118 and ferrule 132". Therefore, the effectors in Edwards, which according to the Office are comprised of chip 106 with microprocessor 92 and spline 76, are not axially spaced apart along the length of the body, as in the current claims.

Edwards therefore does not anticipate the Applicant's invention because Edwards does not disclose the element of at least two separately identifiable effectors or actuators on an elongate body, wherein the effectors or actuators are axially spaced apart along the length of the body. Accordingly, Edwards is deficient in that it fails to teach every element of the rejected claims. Therefore, the Applicants respectfully request that the 35 U.S.C. § 102(b) rejection of Claims 48-52 and 57-68 be withdrawn.

***Claim Rejections - 35 U.S.C. § 103***

Claims 50, 51, 63, 64, and 65 have been rejected under 35 U.S.C. § 103(a) as allegedly being obvious over Edwards et al. (U.S. 6,163,716).

In order to meet its burden in establishing a rejection under 35 U.S.C. §103, the Office must first demonstrate that a prior art reference, or references when combined, teach or suggest all claim elements. See, e.g., *KSR Int'l Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1740 (2007); *Pharmastem Therapeutics v. Viacell et al.*, 491 F.3d 1342, 1360 (Fed. Cir. 2007); MPEP § 2143(A)(1). In addition to demonstrating that all elements were known in the prior art, the Office must also articulate a reason for combining the elements. See, e.g., *KSR* at 1741; *Omegaflex, Inc. v. Parker-Hannifin Corp.*, 243 Fed. Appx. 592, 595-596 (Fed. Cir. 2007) citing *KSR*. Further, the Supreme Court in *KSR* also stated that that “a court *must* ask whether the improvement is more than the predictable use of prior art elements according to their established functions.” *KSR* at 1740; emphasis added . As such, in addition to showing that all elements of a claim were known in the prior art and that one of skill had a reason to combine them, the Office must also provide evidence that the combination would be a predicted success.

Claims 50, 51, 63, 64 and 65 ultimately depend from Claim 48. An element of the rejected claims is the presence of at least two separately identifiable effectors on an elongate body, wherein the effectors are axially spaced apart along the length of the body, and wherein each of the at least two effectors comprises a transducer and an identifiable processor. The effectors are electrically coupled to the at least two common conductors through a surface penetration of the surface the body on which the effectors have been mounted.

Edwards (U.S. 6,163,716) is deficient in that it fails to teach or suggest the element of at least two separately identifiable effectors or actuators on an elongate body, wherein the effectors or actuators are axially spaced apart along the length of the body, as discussed above. Edwards fails to teach this element because chips 106 in Edwards are arranged radially around stainless steel ferrule 136 as shown in

FIG. 21 above. Therefore the "effectors" in Edwards are not axially spaced apart along the length of the body, as in dependent claims Claims 50, 51, 63, 64 and 65.

Furthermore, Edwards fails to suggest this element, because the chips 106 in Edwards need to be in close proximity, in order to allow electrical connection between the chips via ferrule 136 and microconnector 92 as disclosed below:

"As FIG. 20 and 21 show, a stainless steel ferrule 136 electrically interconnects the lines of the circuit 120 with the microconnector 92. The ferrule is located within the distal end of the mylar tube 118. The ferrule 136 has a prescribed array of 32 cone points 138. The cone points 138 electrically interconnect the appropriate power (+) and (-) lines 122 and 124, the control input line 126, and the signal output line 128 to the associated contacts 110/112/114/116 of the I/O buss 108 of each chip 106." (col. 10, lines 7-15)

It is respectfully submitted that Edwards does not suggest the element of effectors that are axially spaced apart along the length of the body, because the device in Edwards is designed such that "the number of electrically conductive wire leads passing through lumen 64 is minimized by using solid state microconnector 92 in the base member 72" (col. 9, lines 8-11). Therefore, Edwards does not suggest the element of "effectors" spaced axially along the length of the body, because if chips 106 in Edwards were axially spaced apart along the length of the body, they would not allow the use of microconnector 92.

Therefore, the Applicants maintain that Edwards does not teach or suggest the element of at least two separately identifiable effectors or actuators on an elongate body, wherein the effectors or actuators are axially spaced apart along the length of the body. Consequently, the Applicants respectfully request that the 35 U.S.C. § 103(a) rejection of Claims 50, 51, 63, 64 and 65 be withdrawn.

Finally, newly presented Claims 96-113 are patentable for at least the reasons provided above.

**CONCLUSION**

In view of the amendments and remarks above, this application is considered to be in good and proper form for allowance and the Examiner is respectfully requested to pass this application to issuance.

The Commissioner is hereby authorized to charge any underpayment of fees associated with this communication, including any necessary fees for extensions of time, or credit any overpayment to Deposit Account No. 50-0815, order number PRTS-012.

Respectfully submitted,

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